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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,220	03/18/2005	Mark C. Tevis	SGI-0084-PCT-US	6257

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EXAMINER

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Arguments

Applicant's arguments filed October 6, 2010 have been fully considered but they are not persuasive.

Appellants submit in the Examiner's Answer dated August 6, 2010, the Examiner acknowledges that U.S. Patent No. 6,899,752 to Sekioka et al. "is not available as prior art under 35 U.S.C. §102 (b) or (e)." Page 3, August 6, 2010 Answer. To remedy this deficiency, the Examiner states that "WO 0240607A1 and AU 200214317A (of the same patent family as US 6,899,752) were published in May 2002, and thus, are available as prior art under 35 U.S.C. 102 (a)." Id. However, a search of the European Patent Office website indicates that WO 0240607A1 published in May 2002 in Japanese and AU 200214317A also published in May 2002 in Japanese. The Examiner appears to be assuming that U.S. Patent No. 6,899,752 includes the same disclosure as that found in applications for the corresponding Japanese language publications. As stated in Appellant's Appeal Brief, the Examiner has never provided any information regarding the content of any Japanese language publications. As such Appellants are not in a position to ascertain whether such references are proper 102 (a) references and the Examiner has not provided any information in support of the position that such references are proper. Indeed, although the Examiner maintains that the AU 200214317A reference is not cited in the Examiner's Answer "for convenience", it is respectfully submitted that the Examiner would be required to provide a translation of such reference with citation to appropriate sections in order to meet her burden under the rules. If the AU 200214317A reference is allowed to stand as a proper 102(a) reference, Appellants reiterate the other arguments presented in the Appeal Brief and incorporated by reference herein as to why the presently pending claims patentably

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define over U.S. Patent No. 6,899,752 to Sekioka et al. For the reasons stated above, it is Appellants' position that the Examiner's rejection of claims has been shown to be untenable and should be reversed by the Board.

The Examiner respectfully disagrees with this argument. According to MPEP rules, Applicants entering the national stage in the U.S. are required to file an English translation of the international application if the international application was filed in another language.

Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation. See MPEP 1893.01(d) [R-5]. The claims of an international application may be amended under PCT Article 19 after issuance of the search report. The description and drawings may not be amended under PCT Article 19. The amendment is forwarded to the U.S. Designated Office by the International Bureau for inclusion in the U.S. national stage application. See MPEP 1893.01(a)(2) [R-3].

Therefore, it is a statutory requirement for the description and drawings of U.S. Application entering national stage to be identical to description and drawings of the international application. In other words, the disclosure of U.S. Application entering the national stage in the U.S. is identical to the disclosure of international application simply due to filing requirements.

Therefore, at least the disclosure of WO 0240607A1 (as being a published international application PCT/JP01/10065) is identical to the disclosure of U.S. Patent No. 6,899,752.

Further, U.S. Patent No. 6,899,752 to Sekioka et al. is CONTINUATION (not continuation-in-part) of international application PCT/JP01/10065 which is published in Japanese on May 23, 2002 as WO 0240607A1. In other words, no new matter was added to

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claims of the international application PCT/JP01/10065 under PCT Article 19 upon entering national stage in the U.S., and thus, WO 0240607A1 should be identical to U.S. Patent No. 6,899,752 to Sekioka et al.

Therefore, in contrast to Appellants' assertion, WO 0240607A1 is a proper prior art under 35 U.S.C. 102 (a) since the grounds rejection over Sekioka et al. are based on the disclosure only, and since at least the disclosure of WO 0240607A1 is identical to the disclosure of U.S. Patent No. 6,899,752 simply by statutory requirements. Thus, there is no need to supply translation of WO 0240607A1, as requested by Appellants.

In the Examiners' Answer mailed on August 6, 2010, Examiner stated at Page 3 that both WO 0240607A1 and AU 200214317A are available as prior art under 35 U.S.C. 102 (a), but recited AU 200214317A in the grounds of rejections. Appellants submitted a request with the Reply Brief filed on 10/6/2010 to supply English translation of AU 200214317A. However, PTO specialists found out that AU 200214317A is not available as AU publication but available only in the form of WIPO document as WO 0240607 (See attached IP Australia paper).

Although the Examiner recited AU 200214317A in the grounds of rejection, clearly, the rejections of claims stand over WO 0240607A1 as well because the Examiner stated in the Examiner's Answer that both WO 0240607A1 and AU 200214317A are available as prior art under 35 U.S.C. 102 (a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1715

November 10, 2010

/Elena Tsoy Lightfoot/